Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte EDMOND ROUSSEL,
CHARLES LEGRAND, MARC LEGRAND,
NATHALIE ROLAND, and ALAIN OURY

Appeal No. 2003-0066
Application No. 09/331,554

ON BRIEF

Before WINTERS, MILLS, and GRIMES, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

REMAND TO THE EXAMINER

It is unclear from the record which claims stand or fall together on appeal. This issue must be addressed before we reach the merits of the rejections. We therefore remand the application to the examiner for appropriate action.

Claims 13-16, 19-21, 24-26, 29, and 30 are pending and on appeal. In the section of the Appeal Brief headed "Grouping of Claims," Appellants stated that

A. Claims 13, 14, 16; 20, 21 and 24 stand or fall together.
B. Claims 15, 25 and 26 stand or fall together.
C. Claims 19, 29 and 30 stand or fall together.

Page 11.

In arguing the claims, however, Appellants did not follow the same claim groupings set out on page 11. Instead, Appellants argued claim 14 separately from all the other claims, and also argued claims 16 and 24 together and separately from the other claims. Thus, the claim groupings actually argued amounted to:

A. Claims 13, 20, and 21.
B. Claim 14.
C. Claims 15, 25, and 26.
D. Claims 16 and 24.
E. Claims 19, 29, and 30.

The requirements for a brief to this board are set out in 37 CFR § 1.192. In particular, 37 CFR § 1.192(c)(7) states that, for each ground of rejection that applies to more than one claim, the Board will base its decision on a single claim from among those rejected, unless "a statement is included that the claims of the group do not stand or fall together and . . . appellant explains why the claims of the group are believed to be separately patentable."

In this case, Appellants grouped the claims one way in their "Grouping of Claims," and grouped them a different way in their arguments. Thus, it is unclear from the brief which grouping of claims Appellants actually intend to rely on. Our uncertainty has been compounded by the examiner's treatment of the claim groupings.

The examiner noted that "the appellants have not properly argued the claims according to their groupings." Examiner's Answer, page 3. Nonetheless, the examiner "respond[ed] to arguments as if the appellants ha[d] properly

argued the groups. Therefore, only the broadest claim of each group A, B and C [was] carefully addressed." Id. With respect to Appellants' initial group A, the examiner responded to Appellants' arguments only with respect to claims 13 and 20. See the Examiner's Answer, pages 5-7. The examiner did not respond to the separate arguments made by Appellants with respect to claims 14, 16, and 24.

This was incorrect. We have previously held that an appellant's separate arguments should not automatically be dismissed for failure to comply with the rule. See Ex parte Schier, 21 USPQ2d 1016, 1018 (Bd. Pat. App. Int. 1991) (Where a brief has a statement that the claims do not stand or fall together or separate arguments, but not both, "it is imperative that the inconsistency apparent on the face of the brief be resolved.").

Rule 192 provides that "[i]f a brief is filed which does not comply with all the requirements of paragraph (c) . . ., appellant will be notified of the reasons for noncompliance and provided with a period of one month within which to file an amended brief." 37 CFR § 1.192(d). Thus, after recognizing that Appellants' brief did not comply with 37 CFR § 1.192(c)(7), the examiner should have issued a notice of noncompliance with 37 CFR § 1.192, and provided Appellants with an opportunity to correct the defect.

By refusing to address Appellants' separate arguments with respect to claims 14, 16, and 24, the examiner effectively held that Appellants had waived those arguments. We decline to follow the examiner's lead in this matter until Appellants have had an opportunity to correct the defect in their brief.

On return of this case, the examiner should notify Appellants that their brief does not comply with 37 CFR § 1.192(c), and provide them with the appropriate time period in which to correct the claim groupings set out in the brief. If Appellants waive their separate arguments with respect to claims 14, 16, and 24, the examiner may wish to rely on the Examiner's Answer already filed. If, however, Appellants correct the "Grouping of Claims" to indicate that claim 14 is intended to stand or fall by itself and claims 16 and 24 are intended to stand or fall separately from the other claims, the examiner should respond to Appellants' arguments with respect to these claims.

We authorize the examiner to file a Supplemental Examiner's Answer responsive to Appellants' amended appeal brief. If a Supplemental Examiner's Answer is filed, Appellants are entitled to file a Reply Brief. See 37 CFR § 1.193(b)(1).

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

Sherman D. Winters)
Administrative Patent Judge)
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)
Demetra J. Mills) BOARD OF PATENT
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